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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/06/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/146,835

Applicant(s)  
Ito et al

Examiner  
Mark Wallerson

Art Unit  
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 2/11/2002 and 2/19/2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-9, 23, and 34-41 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-9, 23, and 34-41 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some\* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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**Part III DETAILED ACTION**

***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendments filed on **2/11/2002 and .**
2. This application has been reconsidered. Claims 1-9, 23, and 34-41 are pending.

***Continued Prosecution Application***

3. The request filed on 2/11/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/146,835 is acceptable and a CPA has been established. An action on the CPA follows.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claims 2, 3, and 4 recite the limitation "selecting means" in line 2 of the claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1, 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizoguchi (U. S. 5,805,215).

With respect to claims 1 and 23, Mizoguchi discloses a digital camera (figure 2) comprising a memory (MC) which is separable from the camera; a picture capturing unit (2) for capturing picture information corresponding to an image and for storing the picture information in the memory (column 5, lines 16-36); a control information processor (45 or 50) for storing in the memory a processing method (which reads on added information for accessing the images) for indicating how the picture information is to be processed (retrieved) (column 7, lines 2-37), the

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processing method selected after the picture information is captured (column 6, line 52 to column 7, line 60), the processing method remaining on the memory after the memory is separated from the camera (which reads on the additional information being used when the memory is searched by another search unit) (column 9, lines 21-27), and the picture information is processed from the memory when the memory is separated from the camera (which reads on the additional information being used when the memory is searched by another search unit) (column 9, lines 21-27).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 5, 23, 34, 35, 36, 37, 38, 39, 40, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Lathrop (U. S. 5,563,655).

With respect to claims 1, 5 and 23, Lathrop discloses a digital camera (12) comprising a memory (10) which is separable from the camera; a picture capturing unit (30) for capturing picture information corresponding to an image and for storing the picture information in the memory (column 4, lines 18-24); a control information processor (20 or 50) for storing in the memory a processing method (which reads on an algorithm) for indicating how the picture information is to be processed (column 2, lines 16-24), the processing method selected after the

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picture information is captured (column 2, lines 16-31), the processing method remaining on the memory after the memory is separated from the camera (which reads the read function can be activated from a printer) (column 4, lines 57-61), and the picture information is processed from the memory when the memory is separated from the camera (column 5, lines 50-64).

With respect to claims 34-39, Lathrop discloses the picture information is processed based on the processing method stored in the memory, and indicates to an external device how to create an image from the stored picture information (which reads on how the image is to be rendered) (column 7, lines 17-29).

With regard to claims 40 and 41, Lathrop discloses that the processing method is user selected (column 5, lines 8-12).

### *Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lathrop in view of Lourette (U. S. 5,978,016).

With regard to claims 2 and 4, Lathrop differs from claims 2 and 4 in that he does not clearly disclose selecting a picture to be displayed. Lourette discloses the picture selecting means

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is for selecting the picture to be transmitted and printed (in the photofinisher), and the stored information relates to the transmission and printing of the picture (column 17, lines 35-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop to select a picture to be displayed. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop by the teaching of Lourette in order to improve operator control.

With respect to claim 3, Lathrop differs from claim 3 in that he does not clearly disclose selecting means for selecting the picture to be displayed, and the stored information relates to the display of the picture. Lourette discloses the picture selecting means is for selecting the picture to be displayed, and the stored information relates to the display of the picture (column 15, lines 15-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop to include selecting means for selecting the picture to be displayed, wherein the stored information relates to the display of the picture. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop by the teaching of Lourette in order to improve operator control.

With respect to claim 6, Lathrop differs from claim 6 in that he does not clearly disclose selecting a picture corresponding to an order person. Lourette discloses selecting a picture corresponding to the order person and information corresponding to the order person (column 17, lines 4-56 and column 19, lines 1-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop to select a picture according

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to order information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop by the teaching of Lourette in order to improve operator control.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lathrop in view of Lourette as applied to claim 1 above, and further in view of Petruchik (U. S. 5,619,738).

With respect to claims 7, 8, and 9, Lathrop as modified differs from claims 7, 8, and 9 in that he does not clearly disclose storing information about a rotation angle of the picture.

Petruchik discloses means for storing print orientation information (column 5, lines 58-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop as modified to store information about a rotation angle of the picture. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Lathrop as modified by the teaching of Petruchik in order to more easily define the exposure.



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***Response to Arguments***

15. Applicant's arguments with respect to claims 1-9 and 23 have been considered but are moot in view of the new ground(s) of rejection.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

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MARK WALLERSON  
PATENT EXAMINER

MARK WALLERSON